

AMENDMENT UNDER 37 C.F.R. § 1.111
U.S. Application No. 10/520,426

REMARKS

Review and reconsideration on the merits are requested.

Formalities

The Information Disclosure Statement

Applicants submit herewith a fresh PTO/SB/08 listing the Abstract of JP 50137911, which the Examiner did not initial on the PTO/SB/08 which the Examiner returned.

Consideration is requested.

It is noted that this reference was cited in the English International Search Report, copy attached to the Examiner's reference.

The Examiner is requested to consider MPEP at page 600-148, Rev. 3, August 2005, which provides:

Where the information listed is not in the English language, but was cited in a search report or other action by a foreign patent Office in a counterpart foreign application, the requirement for a concise explanation of relevance can be satisfied by submitting an English-language version of the Search Report or Action, which indicates the degree of relevance found by the foreign office. This may be an explanation of which portion of the reference is particularly relevant, to which claims it applies, or merely an "X", "Y", or "A" indication on the Search Report.

While Applicants believe that all references in the early submitted PTO/SB/08 are properly considered, in view of the International Search Report (copy attached), they do submit

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for the Examiner's consideration an English Abstract which was obtained from a CA File on a STN search, 85:32608 CA.

Priority

Applicants appreciate the Examiner acknowledging a certified copy of the priority document. There is only one priority document.

Response to Restriction

Applicants believe that all claims should now be in condition for allowance and request examination of all claims.

Prior Art

CA abstract of Mueller et al, Archiv der Pharmazie und Berichte der Deutschen Pharmazeutischen Gesellschaft (1968), 301(2), 161-7, STN search result (Mueller).

The Rejections

Applicants first address the rejections under 35 U.S.C. § 112, and then the rejection under 35 U.S.C. § 102(b).

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Claim Rejections - 35 U.S.C. § 112

With respect to claims 1-5, "phenol derivative" is canceled and --compound-- used. If the Examiner wishes "phenol" to be in the claims, the Examiner is authorized to insert that term.

With respect to the rejection of claim 4 as being incomplete in omitting the description of catalytically hydrogenating a (phenol) compound, claim 4 is so amended. Clearly this makes claim 4 complete.

Claim 5 is rejected on similar grounds, the Examiner urging the omitted step is description of a removing phthaloyl group of the phenol compound.

With respect to claim 5, Applicants respectfully submit that removing the phthaloyl group (the spelling of phthaloyl is corrected) in claim 5 represents an active positive step in the process and the Examiner is in error.

A telephone interview was conducted on the rejection of claims 4 and 5 and the Examiner stated that specific catalysts and phthaloyl removing agent should be recited in the claims. Applicants believe that so limiting the claims would be unduly restrictive, and submit herewith with respect to the rejection of claim 5 for the Examiner's consideration PROTECTIVE GROUPS AND ORGANIC SYNTHESIS Greene et al (3rd Edition, page 564-566 and copyright notice).

Applicants advise that the nine literature citations provided herewith are taken from the references in Greene et al. These references generally deal with cleavage-type reactions and show different types of procedures for cleavage-type reactions. It is believed that they support

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Applicants position. If the Examiner would like a detailed explanation on these publications, the undersigned can obtain further analysis and comments from the Inventors.

Applicants submit that Greene et al and the provided publications establish that one of ordinary skill in the art would easily have been able to use other means of removing the phthaloyl group.

Withdrawal is requested.

Claim 6 is added directed to certain of the catalysts at the bottom of page 5 of the specification and claim 7 to the material at page 6, lines 20-22.

Claim Rejections - 35 U.S.C. § 102(b)

Claims 1 and 2 are rejected as anticipated by Mueller. The Examiner does indicate that "However, claim 3 is potential allowable."

In traversing, Applicants rely upon the recent decision of the Board of Patent Appeals and Interferences, Ex parte Bonfils, 64 USPQ2d 1456 (Board of Patent Appeals and Interferences, 2002), copy attached.

In Bonfils, the Examiner was to reject certain compound claims as obvious over prior art where the claimed compounds were stereoisomers of the compounds taught in the prior art. Here the Examiner has posed an **anticipation** rejection. However, unless Mueller teaches the stereochemical configuration of the present compounds, an anticipation rejection is not proper. The four factors which led to reversal in Bonfils decision were as follows:

The prior art did not teach the specifically claimed configuration;

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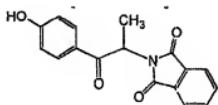
The prior art did not enable one of ordinary skill in the art to make the specifically claimed configuration of the compounds (which were steroids);

Evidence of record showed that the pharmaceutical activity of a new single stereoisomeric form was not easy to envisage compared to a known stereoisomeric form or a known racemic mixture; and

One of ordinary skill in the art would not have been able to predict the discovered utility (effect on spermazoid levels based on the known antilipemic activity of the prior art compounds.

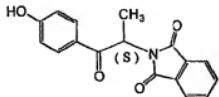
Applicants apply the above factors in Bonfils to the present application below.

Factor 1: In Mueller, there is no description of the specifically claimed configuration, Mueller teaches only a racemic mixture, DL-p-Hydroxy- α -phthalimidopropiophenon, represented by the following formula:



Thus, Factor 1 in Bonfils is presented in the present situation.

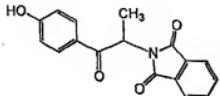
Factor 2: Mueller does not describe or suggest any method of making the specifically claimed configuration of the compound represented by the following formula:



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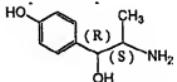
Thus, Factor 2 in Bonfils is met since Mueller does not enable one of ordinary skill in the art to make the specifically claimed configuration of the present invention.

Factor 3: Mueller does not describe the pharmaceutical activity of the compound represented by the following formula:



Thus, Factor 3 in Bonfils is met.

Factor 4: The present invention relates to intermediates of the compound represented by the following formula:



which is an intermediate of medicaments and described to be useful in manufacturing, for example, agents for the prevention or treatment of obesity, hyperglycemia or a disease caused by intestinal tract hypermotility.

In distinction, Mueller relates only to a method of thyronine-like derivatives.

Accordingly, Factor 4 of Bonfils is met, since one of ordinary skill in the art would not have been enabled to predict the discovered utility from Mueller.

In short, Mueller fails under all of the Bonfils factors. Accordingly, withdrawal of the rejection of Mueller is requested.

Withdrawal of all rejections and allowance is requested.

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In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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